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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,564	03/23/2001	George Herry Hoffman	41556/04716 (RS11P062)	7118
22428	7590	10/08/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			ZEENDER, FLORIAN M	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/816,564

Applicant(s)

HOFFMAN, GEORGE HERRY

Examiner

F. Ryan Zeender

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/7/01, 10/25/02, 5/30/03, 1/29/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 7, and 13; the terminology, "the supply chain manager" lacks antecedent basis.

In claims 3, 9, and 15; the terminology, "the electronic order form" lacks antecedent basis.

In claims 4, 10, and 16; the terminology, "the distributor" lacks antecedent basis.

Claim 7 and all claims dependent therefrom recite limitations comprising only logic. Since "logic" does not comprise any physical element, the use of the terminology, "A system" appears to be misdescriptive.

### ***Claim Rejections - 35 USC §101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 4-8, and 10-18, as best understood, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-2, 4-8, and 10-12 only recite an abstract idea. The recited steps/logic of merely receiving data, determining rules, and applying the rules do not necessarily apply, involve, use, or advance the technological arts since all of the recited steps/logic can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of reducing costs in a supply chain management framework.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, claims 13-18 do **not** appear to produce a useful, concrete, and tangible result because they recite computer code that is not depicted to be on a computer readable medium.

Therefore, because the recited program does not produce a useful, concrete, and tangible result and the process/system of claims 1-2, 4-8, and 10-12 is not within the technological arts as explained above, claims 1-2, 4-8, and 10-18 are deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-7, 9-13, and 15-18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Shavit et al.

Shavit et al. disclose or inherently teach all of the limitations of the claims including: reducing costs in a supply chain management framework (See for example Col. 6, lines 27-28); receiving data related to the sale of products (See for example Col. 6, lines 30-36); determining and applying rules to ensure minimal costs (See for example Col. 6, lines 19-51) without requiring the supply chain manager (i.e., management system 50) to take title to any goods; rules indicate a distributor to which the electronic order form is to be sent including an amount of product (see for example Col. 12, lines 42-65); forecasting as a function of the rules (Col. 7, line 19); and promotion planning as a function of the rules (See for example Col. 6, line 48).

***Claim Rejections - 35 USC § 103***

Claims 2, 8, and 14, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. in view of Sharp et al. US6263317.

Shavit et al. disclose or inherently teach all of the limitations of the claims except the rules determined by a brand owner.

Sharp et al. disclose a similar supply chain management system whereby rules governing product sales are determined by brand owners.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Shavit et al. to have the rules determined by a brand owner, in view of Sharp et al., in order to “ensure that sales of brand-name goods and services via the Internet do not violate existing distribution agreements between the manufacturers and their respective distributors and retailers” (See Sharp et al., Col. 1, lines 59-62).

***Relevant Prior Art***

The assignee, Restaurant Services Inc. (RSI), launched a product (RSI/Link) “to collect sales, shipment, pricing, and inventory information from Burger King’s 350 suppliers and distributors” (See “A Whopping Inventory Task”) in 1994.

The article “Burger King Orders AT&T Mail Service” discusses how “the E-mail network will replace a manual, paper-based tracking and ordering system.”

***The Examiner requests that the applicant provide the Office with any known information relevant to the above mentioned product launch.***

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The additional prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Ryan Zeender whose telephone number is (703) 308-8351. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Olszewski can be reached on (703) 308-5183. The receptionist's phone number for the Technology center is (703) 308-1113.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 for before-final communications.

F. Zeender  
Primary Examiner, A.U. 3627  
September 16, 2004

 9/16/04  
F. RYAN ZEENDER  
PRIMARY EXAMINER